

II. REMARKS

See below.

III. SUMMARY OF CLAIMS, OFFICE ACTION, AND RESPONSE

Claims 32-97 are pending.

Claims 92-97 are added dependent claims.

The independent claims are 32, 38 44, 50, 54, 57, and 58.

The office action examines claims 32-91. Summary page.

The office action rejects claim 57 under 35 USC 101. Page 5.

The office action rejects claims 31 [sic; 32?], 38, 44, 50, 54, and 57 under the second paragraph of 35 USC 112. Page 4.

The office action rejects claims 32-91 under 35 USC 103 based upon combination of Barnett (USP 6321208) and Shane (USP 5793972). Pages 5-30.

In summary, the claims have been amended in response to the rejections as noted below.

IV. THE OFFICE ACTION REJECTION OF CLAIM 31 [SIC; 32?], 38, 44, 50, 54, AND 57 UNDER THE SECOND PARAGRAPH OF 35 USC 112

A. THE RECITATION "a consumer database which *can* identify consumers by their e-mail addresses"

The office action indicates that claims 31 [sic; 32], 38, 44, 50, 54, and 57 are rejected because they recite the word "can" "which creates some uncertainty."

Claim 32 read:

32. (Previously Presented) A system for delivering incentives over the Internet comprising:

a Web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activity;

a consumer database which *can identify consumers by their e-mail addresses*, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

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Claim 32 clearly indicates that the consumer database stores consumer email addresses. Claim 32 was drafted in the foregoing form to follow closely the language of the specification, page 20 lines 27. Thus, the applicant disagrees with the examiner that claim 32 is indefinite in this respect (and that fact is supported by the objective evidence that no examiner has previously rejected claim 32 in this regard despite repeated appeal filings in this application over several years). However, in order to moot the issue, the applicant amends claim 32 as follows.

32. (Currently amended) A system for delivering incentives over the Internet comprising:

a Web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activity;

a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

Claims 32, 38, 44, 50, and 54 contain the foregoing or a similar recitation and are all amended accordingly.

B. THE RECITATION "A Web site"

The office action states that claim 57 is indefinite because it recites "a web site or data per se in the preamble, while the body of the claim contains structure or means plus function." Claim 57 reads as follows:

57. (Previously Presented) A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:

a personal database;

a purchase history database wherein the data on the consumer purchases are based on online shopping activity;

means for generating a web page with a consumer-specific display;

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means for updating said web page; and
means for informing the consumer by e-mail of new incentives.

In reply, the rejection of claim 57 is improper and should be withdrawn for the following reasons. First, the preamble does not recite "data per se". It recites a "Web site". The conventional definition of a Web site is:

noun: a computer connected to the internet that maintains a series of web pages on the World Wide Web ("The Israeli web site was damaged by hostile hackers").

See the definition from "One Look" at <http://www.onelook.com/?w=Web+site&ls=a> A copy of <http://www.onelook.com/?w=Web+site&ls=a> is Attachment 1 to this amendment.

Similarly, the first definition in the list of computer category definitions on Attachment 1 (NetLingo) explains that:

The main difference between a Web site and traditional media is that a Web site is on a computer network (the Internet) and is coded in such as way that allows users to interact with it. Once you're on a site, you can make purchases, do searches, send messages, and other interactive activities

See the definition for Web Site from Netlingo at:

<http://www.netlingo.com/lookup.cfm?term=Web%20site> A copy of <http://www.netlingo.com/lookup.cfm?term=Web%20site> is Attachment2.

A computer network that is "coded in such as way that allows users to interact with it" is not data per, se. Therefore, claim 57 does not recite "data per se in the preamble." Instead, it recites a "Web site" in the preamble, and it recites structure of a computer network forming part of the Web site, in the body of the claim. Therefore, the preamble and the body of claim 57 are consistent. Therefore, the rejection of claim 57 is improper.

V. THE OFFICE ACTION REJECTION OF CLAIM 57 UNDER 35 USC 101

The office action rejects claim 57 under 35 USC 101 on the theory that a "web site is a collection of web pages, i.e., data per se." In response, the rejection is improper because a Web

site is not data per se for the reasons and supporting evidence presented in discussion of the rejection of claim 57 as indefinite. Therefore, the rejection should be withdrawn.

Moreover, the rejection is improper because the body of claim 57 recites elements of a computer system which is also clearly statutory subject matter.

**VI. THE OFFICE ACTION REJECTION OF CLAIMS 32-91 UNDER 35 USC 103
BASED UPON COMBINATION OF BARNETT (USP 6321208) AND SHANE (USP
5793972)**

A. REQUEST FOR CLARITY

At the outset, the applicant notes that the office action does not correlate teachings in the prior art to claimed limitations. Instead, the statement in the office action in support of the prior art rejections seems to be the examiner's stream of consciousness regarding disclosure or teachings that the examiner believes in the prior art *without reference to the claim language* to which the examiner believes those prior art teachings are relevant. As such, the applicant finds it difficult to determine the basis for the rejections in many respects.

The examiner is requested to expressly identify the claim recitation to which each cited prior art teaching pertains. In this regard, please note that courts generally and the BPAI in particular have repeatedly stated that they will not "scour the record" for evidence supporting a position, and that applies equally as well to statements by an examiner in support of a rejection. As a consequence, to the extent that the applicant does not understand the basis for the rejection, as evidenced from the form and content of the remarks below, the applicant will assert on appeal that the examiner has not made a prima facie case and advise the BPAI to Order the examiner to clarify the record and *remand to the examiner for proceedings consistent with the order*.

B. SUMMARY OF REASONING

In summary, for the reasons presented below, the rejection of amended claim 32 is improper for two reasons. First, the examiner errs in concluding claim 32's recitation of two separate databases would have been legally obvious in view of Barnett's single database. Second, nothing in the prior art would have suggested the newly added limitation in claim 32 ", wherein said consumer purchase history database stores in association with an identification of a consumer identification all items selected and purchased during a transaction by said consumer,".

C. REVIEW OF CLAIM 32 IN VIEW OF THE EXAMINER'S COMMENTS

Since the applicant finds it difficult to discern the examiner's reasoning, the applicant proceeds by identifying each recitation in claim 32, identifying what the applicant believes to be the examiner's position on each recitation, and then providing the applicant's response.

Claim 32 read:

32. (Previously Presented) A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which *can identify consumers by their e-mail addresses*, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering purchasing incentives to consumers by e-mail.

The office action rejects all claims as obvious based upon Barnett and Shane.

D. "A system for delivering incentives over the Internet"

At page 5, the examiner asserts that Barnett discloses "A system for delivering incentives over the Internet". The applicant agrees.

E. "A Web site for providing purchasing incentives from multiple sources;"

At page 5, the examiner asserts that Barnett discloses "a Web site for providing purchasing incentives from multiple sources;". The applicant agrees.

F. "a consumer purchase history database based on consumer online shopping activity;"

At page 5, the examiner asserts that Barnett discloses "a consumer purchase history database based on consumer online shopping activity;" The examiner refers to Barnett's consumer database file 42, user's buying history profile, and the user's demographic data. Page 5, bottom half.

In reply, the applicant does not follow the examiner's reasoning. However, Barnett does disclose a coupon containing a code unique to each user and also encoding a product identification associated with the coupon, and logging consumer identification and product identification contained in the coupon when the coupon is redeemed by purchase of the identified product. Thus, Barnett discloses a system storing in a database a user identification in association with identification of a product for which the corresponding user redeemed a coupon. See Barnett column 7 lines 21-34 which explains that each coupon encodes not just a product identification but also a unique consumer identification. See Barnett column 7 lines 36-41 which explains that it is the product and consumer identification data for the coupons that were redeemed that the redemption center receives from the retail store in which a coupon is redeemed. See Barnett column 7 lines 45-55 which explains that the coupon distribution center receives the coupon redemption information, so called "user specific redemption data" and demographic data, that the coupon distribution center uses for marketing analysis. Notably absent is any conception of association of all product identification data associated with a purchase being stored in association with a consumer identification received during the purchase, transmission of that data to the coupon distribution center, and use of that transaction data by the coupon distribution center uses for marketing analysis.

In contrast, this application discloses that a purchase history database includes identification of all products associated in a transaction with a customer identification provided during the purchase transaction. See the following passages from the specification.

Each customer's purchasing behavior is tracked *only if the customer provides some form of unique identification during the purchase transactions*, such as a check-cashing card, a credit card, a magnetically encoded check, or other form of identification. *The purchase of any of a number of selected items can then be associated with a specific customer id.*, as indicated in block 404, and a system administrator maintains a database of *customer purchase histories*, as indicated in block 406. [Page 19 lines 19-25.]

Delivery of Incentives by E-mail:

As shown in FIG. 15, the system of the invention also has the capability to deliver targeted or untargeted incentives to consumers through their online E-mail

addresses on the Internet or another computer network. Retail stores, indicated by block 20 500, gather purchase data and either the retailers or an independent system administrator *accumulates the consumer purchase history in a database*, indicated at 502. The *database 502 is developed as a result of consumers being uniquely identified on each visit to the store, by use of a frequent shopper card, a credit card or some other form of identification*. [Page 20 lines 16-24.]

The consumer purchase history 502, which was discussed with reference to FIG. 15, is generated and updated from various sources pertaining to the shopping activities of all *identifiable consumers*. *In-store loyalty programs* based on past purchasing activity are one source of such data. Any online shopping activity is another source. [Page 23 lines 6-10.]

maintaining a consumer purchase history database derived in part from accumulated purchase data of identifiable consumers; [Original claim 24.]

In view of the foregoing, the applicant further amends claim 32 to clarify the claimed consumer purchase history database as follows.

32. (Currently amended) A system for delivering incentives over the Internet comprising:
- a Web site for providing purchasing incentives from multiple sources;
 - a consumer purchase history database based on consumer online shopping activity, wherein said consumer purchase history database stores in association with an identification of a consumer identification all items selected and purchased during a transaction by said consumer;
 - a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site;
 - and
 - means for delivering purchasing incentives to consumers by e-mail.

As noted above, Barnett does not disclose a system in which a database stores "in association with an identification of a consumer identification all items selected and purchased during a transaction by said consumer". Barnett's system is incapable of that function because it receives only coupon redemption data.

Claims 32, 38, 44, 50, 54, 57, and 58, have been amended in a similar fashion to distinguish in this respect over Barnett.

Moreover, new dependent claims 92-97 depend from the independent claims and each recite "wherein at least one of said items was not the subject of a redeemed purchase incentive." Negative limitations of this kind are acceptable under the doctrines of inherency and so long as they do not introduce new concepts. See Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998)(" In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure. See Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).") In this application, the specification teaches that the natural result flowing from the disclosed method is a database record which includes in association with a customer identification, identification of all items purchased during a transaction, and that purchase incentives are provided for only some products. Therefore, it is inherent that not all product identifications stored in the database are for products for which a coupon was redeemed. Therefore, new dependent claims 92-97 are supported by the disclosure.

Moreover, claims 92-97 have written descriptive support for the same reasons expressed in the BPAI decision in Ex parte Franks, Appeal No. 2005-0847 (BPAI 9/26/2005), application No. 09/939,689, wherein the panel reasoned that once the applicant provides written description for a genus, written description exists for the genus less one anticipatory condition contained in the prior art. A copy of Ex parte Franks, Appeal No. 2005-0847 (BPAI 9/26/2005 is Attachment 3 to this response. Specifically, in the panel decision in Appeal No. 2005-0847, a claim at issue was claim 39, which read as follows:

39. A composition which is storage-stable at 20° C, comprising:
- (1) a carrier substance which is water-soluble or water-swellaable and is in a glassy state;

(2) at least one material to be stored which is dissolved in said carrier substance;

wherein said composition exists in a glassy state at 20° C;

wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;

wherein said purified biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto;

wherein said composition contains no more than 4 percent by weight of water; and

wherein said biologically active material is not rennin.

Decision page 2. There, the examiner's rejected for lack of written description

asserting "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 21, 31, 37, 39, and 41 ." See *id.*, at pages 3-4.

According to the examiner (Answer, page 4), "[rennin is not mentioned in the disclosure, and silence in the specification is not support for a negative claim limitation." Accordingly, the examiner finds (Answer, page 4), "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 39 and 41." In support of this rejection, the examiner relies on Ex Parte Grasselli, 231 USPQ 339, aff'd on reh'q, 231 USPQ 395 (Bd. Pat. App. & Int. 1983).

In response, appellants admit (Brief, page 1 D), "the specification of this application does not mention rennin." According to appellant, the claims "specifically exclude[] rennin only because of the reference to rennin in the Shah reference." Appellants assert, however, "that [this] does not mean that the applicant's [sic] were not in possession of the genus of the inventions claimed by claims 39 and 41, either including or excluding rennin." According to appellants (Brief, bridging paragraph, pages 11-12),

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there is no rational basis for a rule of law precluding negative limitations that exclude a species anticipating a generic claim when the reference does not teach the generic utility of the claimed invention. That is the case here. To the extent case law is inconsistent with this reasoning, it should be overruled....

Decision page 12. With those issues in mind, the panel held that:

We find the facts on this record to be substantially similar to those in In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). In Johnson, appellants narrowed their claims to avoid having them read on a lost interference count. On this record, appellants narrowed their claims to avoid having them read on the prior art. As set forth in Johnson, at 1019, 194 USPQ

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species there within, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of 31 12, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

The examiner failed to explain why after disclosing the genus - proteins, the subgenus - enzymes, and specifically describing several enzymes within the subgenus, that appellants have not described a composition as set forth in claims 39 and 41, wherein the biologically active material is not rennin. In our opinion, having described the whole, appellants have necessarily described the part remaining. Cf. id.

Accordingly, we reverse the rejection of claims 39 and 41 under 35 U.S.C. 112, first paragraph.

Decision at 13 and 14.

Like in Franks, the applicant here discloses the genus of saving all product identifications for products purchased during a transaction in association with a customer identification presented during that transaction.

Like in Franks, the application therefore has written description support for saving product identifications for products purchased during a transaction that are not associated with coupon redemptions.

- G. **"a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~", wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and"**

1. **THE CLAIMED DATABASE STORING EMAIL ADDRESSES**

At page 6, the examiner asserts that Barnett discloses claim 32's " a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~". That is, the examiner asserts that Barnett discloses a database storing email addresses of consumers. That statement is incorrect. Barnett contains only one reference to email. That sole reference in Barnett to email appears in the following passage:

In a further alternative embodiment of the present invention, the functions of the online service provider 2 are carried out at a site on the Internet. That is, a user may access the coupon data repository by accessing an appropriate Internet site. In this embodiment, the downloaded coupon management routines are encoded with a unique user identification number, which may be for example the user's email Internet address. When the user requests coupon data packages to be transmitted, the user identification number is encrypted and sent to the Internet site along with the request. Appropriate routines are implemented at the Internet site to decrypt the user's identification number and compare it against a list of valid members in order to ensure the validity of the user.

Barnett discloses a database storing a "*unique user identification number*," not an email address. What Barnett states is that the value of the data stored in a field identified as "*unique user identification number*", - - " may be for example the user's email Internet address." merely

provides an example of a data value. Barnett provides no relevance to the "*unique user identification number*," which would otherwise suggest that the user's email Internet address is what is stored in all records for all users in the "*unique user identification number*" field. Barnett provides no suggestion that data stored in the field for "*unique user identification number*," for all users is an email address. Barnett discloses that the sole purpose of the "*unique user identification number*," is to identify the user of the coupon is the user to whom the coupon was provided. Since any "*unique user identification number*" will serve that purpose Barnett teaches that the value of the "*unique user identification number*" is irrelevant. Therefore, nothing in Barnett suggests a database field storing email addresses of consumers.

In contrast, claim 32 recites "a consumer database which stores e-mail addresses of consumers." It is well understood in the database arts that a database that stores data "of" a particular type means that the schema of the database includes field identifications identifying that type. In this case the recitation "email address of consumers" means that the database contains one or more fields identified as "email addresses" in records associated with a consumer identification. Barnett does not disclose or suggest that concept.

2. THE CLAIMED TWO DATABASES

At page 7, the examiner admits that Barnett fails to disclose claim 32's claimed two databases, the claimed "consumer purchase history database" and the claimed "consumer database". Specifically, the examiner statement at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively and to give respective users and/or operators access rights to the stored information." establishes that the examiner considered the two database files recitation, a limitation, and yet the office action does not assert that Barnett discloses that limitation. Cf. Federal Rule of Evidence 801(d)(2)(E) ("(B) Under established principles an admission may be made by adopting or acquiescing in the statement of another. While knowledge of contents would ordinarily be essential, this is not inevitably so: "X is a reliable person and knows what he is talking about." See McCormick § 246, p. 527, n. 15. Adoption or acquiescence may be manifested in any appropriate manner. When silence is relied upon, the theory is that the person would, under the circumstances, protest the statement made in his presence, if untrue. The decision in each case calls for an evaluation in terms of probable human behavior. In civil cases, the results have generally been satisfactory. In criminal cases, however, troublesome questions

have been raised by decisions holding that failure to deny is an admission: the inference is a fairly weak one, to begin with; silence may be motivated by advice of counsel or realization that "anything you say may be used against you"; unusual opportunity is afforded to manufacture evidence; and encroachment upon the privilege against self-incrimination seems inescapably to be involved. However, recent decisions of the Supreme Court relating to custodial interrogation and the right to counsel appear to resolve these difficulties. Hence the rule contains no special provisions concerning failure to deny in criminal cases."'). The examiner's failure to assert Barnett discloses two database files and then relying upon the alternative theory at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively" to suggest the claimed database structure is an admission that the examiner does not believe that Barnett discloses the claimed two database files. Moreover, for the reasons previously presented the applicant also does not believe that Barnett discloses, or suggest, the claimed two database files.

At page 7, the examiner states that an "integrated database file 42 of fig. 6 or into two separate database files respectively is a matter of desires or choice, which does not impact the functionality or utility of the method or system." This is an admission that the examiner does not recognize the utility of two separate database files, which is probative of the fact that one of ordinary skill in the art would not recognize the value of two separate database files, and therefore is probative of the fact that there is no motivation to modify what Barnett and Shane disclose to be what claim 32 defines.

The examiner's conclusion that there is no utility to having two separate database files, as claimed, is incorrect. In this regard, the specification is relevant. The specification states at page 9 lines 24-26 that "the consumer 25 will be required to *enter a valid Internet address for electronic mail (E-mail), and to select a supermarket in his or her area*, as indicated in block 42." and at page 20 lines 9-14 that "Customers who volunteer the necessary linkage in the form of their 10 customer id. may be rewarded in some manner. The customer id. may be requested only once and then used for all subsequent sessions in which the customer logs in to the system. Once the linkage is established, the *consumer purchase history data or targeted incentives needed to support this capability of the invention are periodically transferred from the shopper purchase history system to the on-line system of the present invention.*" The examiner ignores that fact that combining data in a data file for data acquired online from the user and another data file obtained from a retail store presents complications and costs

computer processing time. One complication is whether there are matching records with the same consumer identification in the database file generated online by the interaction with the user and the purchase history data file received from a particular retailer. How will the system handle combining that data into a single file when for example there are records that do not have a common user identification? Moreover, during the presumably long processing time to combine two data files into a single file including the time to determine and associate records which have a common user identification and store records that do not have a common user identification, how will still perform its other functions, of running the interactive Web site and delivering incentives. Memory limitations are also relevant. When combining data into a single file memory size limitations are generally a constraint. Combining data files is impacted by the physical memory size (number of bits of storage) and logical size constraints (number of bits referencable in an operating system) and hierarchical limitations (number of data objects at any level that may be efficiently referenced, such as the number of files in a folder). These details are often non obvious but real and substantive constraints, particularly in large databases. The undersigned discussed this issue with Steve Greenfield of Catalina on 9-25-2008, via telephone, and again on 9-26-2008, via telephone. Mr. Greenfield is a person knowledgeable on software and database structure issues, and very familiar with Catalina's systems relying there upon. Mr. Greenfield confirmed to the undersigned on 9-25-2008 that there were significant differences between use of one or two database files of the type disclosed in the specification and that the issues raised in this paragraph are real. Mr. Greenfield indicates that those concerns were very important in the 1996 time frame due to the much more limited data processing and data storage technology at that time, but are still issues today. Attachment 4 is a copy of the email from Rick Neifeld (the undersigned) to Steve Greenfield 9-26-2008 (redacted), showing what Mr. Greenfield reviewed and found accurate. The examiner has not considered, and this is probative that one of ordinary skill in the art, would not have considered in view of the teachings in Barnett and Shane, these issues. Therefore, it appears that (1) there are reasons why "integrated database file 42 of fig. 6 or into two separate database files... does ... impact the functionality or utility of the method or system." Moreover, the examiner's statements on the record are probative that such reasons would not have been recognized by one skilled in the art, which indicates that the claim including the claimed database structure, expressly claiming two databases, would not have been obvious.

H. **"means for delivering purchasing incentives to consumers by e-mail."**

At page 6, the examiner expressly admits that Barnett does not disclose claim 32's "means for delivering purchasing incentives to consumers by e-mail." The examiner states that "Barnett does not ... mention e-mailing coupon data or purchase incentives to the user for subsequent printing." In response, the applicant agrees.

From the end of page 6 to the top of page 8, the examiner discusses Shane. However, the applicant cannot discern the relevance of the examiner's comments.

Shane discloses a "System and method providing an interactive response to direct mail by creating personalized web page based on URL provided on mail piece". Title. Shane discloses:

A system for providing an interactive response to direct mail programs comprises a recipient database, a mail generator, and a web server computer operationally connected through the Internet to remote computers accessible by direct mail recipients. The recipient database stores data records containing addressing information such as the name, mail, fax or e-mail address, and a unique personal identification code for each direct mail recipient. The mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient. A responding recipient accesses the web server computer by entering the uniform resource locator displayed on the direct mail piece into a web browser on a remote computer. The web server computer retrieves recipient data from the recipient database correlated to the personal identification code contained in the uniform resource locator and uses this recipient data to create a unique interactive web page. [Abstract.]

Respecting email, Shane contains two relevant teachings.

First, Shane contains in the background section the following caution teaching away from using emails for marketing:

Electronic mail ("e-mail") is one possible solution for advertisers. Despite its allure, however, promotional e-mail is still frowned upon, and at present its content is generally limited to unformatted text without graphics. The sender is

not even able to determine the font of the e-mail message. Additionally, targeted e-mail lists are not yet available for advertisers. [Column 1 lines 31-37.]

Second, Shane discloses the following alternative implementation at the end of its disclosure, which relies upon email to the user's email address:

While one aspect of the subject invention has been illustrated and described as involving direct mail pieces comprising printed materials assigned postal addresses and sent through standard postal delivery systems (such as through the post office or by courier), it should be understood that with simple and obvious modifications, any form of targeted one-to-one communication may be used in the system or method of the claimed invention. Accordingly, the direct mail pieces may comprise electronic data files provided with e-mail addresses and sent by e-mail. Alternatively, the direct mail pieces may comprise faxes sent by facsimile transmission to specified phone numbers. [Column 8 lines 10-21.]

Thus, Shane does disclose direct one to one communication via email, but also generally teaches away from using email for marketing.

I. RATIONALE FOR MODIFYING BARNETT IS UNCLEAR

From the bottom of page 8 to the end of page 9, the examiner asserts that Shane suggests modifying Barnett:

to record the user's demographic information including the user's identifying data, e.g. unique code, e-mail address and so on, in a database file 42 of fig. 6 and the user's buying history (online/offline shopping activity) in another and separate database or database file and to enable two different and independent operators or authorized employees, with appropriate rights, to access the respective databases or database files to separately maintain and analyze the data contained therein in order to generate individual user's profile information, based on the collected demographic data and buying history respectively, which is used to produce a merged or combined user's profile useful in crafting targeted coupon data or

purchase incentives that are sent to the specific user via e-mail, wherein the content of the e-mail is subsequently printed at the user's computer 6 of fig. 1 using a printing device coupled thereto, thereby ensuring that the user's (combined) profile, generated from data contained in the database files (consumer database and consumer purchase history database respectively) and used by the issuers or sources to prepare customized coupon packages or purchase incentives e-mailed to the specific user, is accurate and independently produced by two different and independent operators or authorized employees before the result of the independent analyses is merged or combined to form the user's profile, while pro-actively targeting the user by e-mailing customized coupon data packages to the user, based on the combined profile, without the user's intervention or without the user visiting the online service provider 2 web site to view or request the coupon data packages therefrom.

The applicant cannot discern the meaning of the foregoing statement, other than that the examiner asserts that the applied prior art in combination suggests claim 32. For example, the foregoing statement does not follow the rules of English grammar, and it does not specify particular motivation for particular modifications of Barnett's teachings.

In response, for the reasons presented above in connection with the invention defined by claim 32, the examiner errs in concluding that "another and separate database or database file" would have been obvious. Therefore, claim 32's recitation of "A system for delivering incentives over the Internet comprising: ... *a consumer purchase history database* based on consumer online shopping activity [and] *a consumer database which stores e-mail addresses of consumers* " patentably distinguish over the applied prior art.

Similar analysis applies to the obviousness rejections of independent claims 32, 38, 44, 50, 54, 57, and 58, and the rejections of these claims are improper for similar reasons.

VII. CONCLUSION

This application should now be allowed.

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Date

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